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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/796,979 | 03/11/2004 | Xavier Blin | 05725.1343-00 | 4617 |
| 22852 7590 05/05/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | | |
| EXAMINER ROYDS, LESLIE A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1614 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 05/05/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/796,979

Applicant(s)

BLIN ET AL.

Examiner

Leslie A. Royds

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-28, 36-43 and 45-56.
Claim(s) withdrawn from consideration: 29-35 and 44.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614

/Leslie A. Royds/
Patent Examiner, Art Unit 1614

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant requests reconsideration of the instant rejection of claims 1-28, 36-43 and 45-56 under 35 U.S.C. 103(a) on the following grounds:

- (1) Applicant submits that one of ordinary skill in the art would not have been motivated to combine the teachings of O'Lenick with that of Arnaud to arrive at the presently claimed invention. Applicant alleges that, upon consideration of all of the facts, the combination of references does not render the present claims obvious;
- (2) Applicant further alleges that the present disclosure teaches that the instant invention improves upon the limited teachings of O'Lenick;
- (3) Applicant states that O'Lenick fails to disclose the claimed polyester in combination with an oil having a molar mass from 650-10,000 g/mol; and
- (4) Applicant alleges that the secondary reference to Arnaud teaches away from the instant invention, because it teaches that certain high molecular mass esters are not desirable to provide good sensory properties of cosmetic products.

Applicant's traversal has been fully and carefully considered, but fails to be persuasive.

Firstly, in response to Applicant's allegations that there is no motivation provided to combine the two cited references, Applicant is first directed to the final rejection at p.6, para.3, which expressly provides a statement of motivation to combine the teachings of O'Lenick with the teachings of Arnaud et al. Such an explanation will not be repeated herein so as not to burden the record, but is herein incorporated by reference. In view of this statement of motivation, and further in the absence of any SPECIFIC reasons advanced by Applicant as to why, in fact, one of ordinary skill in the art would not have been motivated to combine the teachings of these two references, the motivation remains valid, absent evidence to the contrary. Applicant's asserted lack of motivation amounts to no more than an allegation without factual support. As set forth in MPEP §2145, "The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)."

Secondly, in response to Applicant's allegation that the present disclosure teaches that the instant invention improves upon the limited teachings of O'Lenick, Applicant has failed to present any comparison of the instantly claimed invention with that of the closest prior art (which, in the instant case, appears to be the prior art invention to O'Lenick) in order to properly demonstrate that the instantly claimed invention does, in fact, demonstrate improved properties relative to the cosmetic of this reference. In the absence of such a comparison, Applicant's statements that the instantly claimed invention show improved properties over the cited prior art to O'Lenick also amount to an allegation in the absence of factual support and, accordingly, are also unpersuasive (In re Schulze, In re Geisler, citations supra). Note also that In re Burckel 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) held that, "An affidavit or declaration under 37 C.F.R. 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness." In the absence of a direct comparison with the closest prior art to O'Lenick, Applicant has failed to establish, on its face, that the instantly invention demonstrates any unexpected or superior effects over that of the cited prior art and Counsel's speculation or assertions to this effect fail to be persuasive in this regard.

Thirdly, in response to Applicant's allegation that O'Lenick fails to disclose the claimed polyester, the basis of this argument is unclear. Applicant again advances no specific reasons elucidating how the teachings of O'Lenick fail to teach the claimed polyester. Note that p.3-4 of the previous Office Action clearly set forth the polyester that is taught by O'Lenick and Applicant has failed to point out how this polyester does not, in fact, meet the limitations of the claimed polyester. Once again, in the absence of specific reasons to this effect, such an argument amounts to an allegation by Counsel and is, accordingly, unpersuasive.

Fourthly, and lastly, in response to Applicant's allegation that Arnaud et al. teaches away from the instantly claimed invention because it teaches that certain high molecular mass esters are not desirable to provide good sensory properties of cosmetic products, Applicant is reminded that, though this disclosure in Arnaud et al. may teach away from CERTAIN synthetic liquid esters with high molecular masses, such a teaching does not focus on the claimed subject matter and why the references as combined teach away from arriving at a combination of the same type as instantly claimed. The fact that Arnaud et al. teaches that CERTAIN high molecular mass esters are not desirable does not address the esters that would otherwise not have such undesirable properties and, therefore, would have commended themselves to one of ordinary skill in the art at the time of the invention to be combined with the oil and composition elements as taught by O'Lenick. Accordingly, this argument is also unpersuasive.

For these reasons set forth supra, and those previously made of record in the final rejection dated November 1, 2007, rejection of claims 1-28, 36-43 and 45-56 remains proper and is maintained.